UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,587	09/15/2003	Kuo-Jung Hsu	TOP 322	8059

23995 7590 10/02/2006

RABIN & Berdo, PC
1101 14TH STREET, NW
SUITE 500
WASHINGTON, DC 20005

EXAMINER	
SHERMAN, STEPHEN G	

ART UNIT	PAPER NUMBER
2629	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/661,587	HSU, KUO-JUNG	
	Examiner	Art Unit	
	Stephen G. Sherman	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 August 2006 has been entered. Claims 1-16 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 2, 4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramey et al. (US 6,756,971) in view of Manser et al. (US 6,388,660).

Regarding claim 1, Ramey et al. disclose a notebook computer with a hidden touch pad (Figure 8, notebook computer 30), comprising:

a main portion including a housing portion (Figure 8 can be seen to have a main housing portion 32.),

wherein the housing portion has an internal surface having an receiving portion (Figure 8. The surface 34 of housing 32 would have an internal surface, where the touch pad guard 60 would be a part of the housing 32, and the underside of surface 62, as better seen in Figure 9, would then be an internal surface of the housing. The inner surface of touch guard 60 would then be the portion of the internal surface of the housing. This internal surface would then have a receiving portion in order to have the touch pad close to the external area of the housing for a user to utilize the touch pad 12.);

a display connected to the main portion in a rotatable manner (Figure 8, computer screen 30 is connected to the housing 32 in a rotatable manner as explained in column 4, lines 28-45.); and

a touch pad disposed onto the receiving portion (Figure 8, touch pad 12 is disposed onto the receiving portion of the interior surface of the housing 32 near the top surface 34 to facilitate the user thereof.);

wherein the internal surface prevents the touch pad from being exposed to an atmosphere outside of the housing portion (Figures 8 and 9 show that when the touch guard 60 is in the closed position that the touch pad 12 is prevented from being exposed to an outside atmosphere of the housing portion 32.).

Ramey et al. fails to teach wherein the receiving portion of the internal surface prevents the touch pad from being exposed to an atmosphere outside of the housing portion.

Manser et al. disclose of a notebook computer with a hidden touchpad wherein a receiving portion of an internal surface prevents the touch pad from being exposed to an atmosphere outside of the housing portion (Figure 7 shows that the housing surface 86 has two slidable pad covers 72 and 82 which can cover the receiving portion for the touch pad 80 such that the touch pad is protected from an atmosphere outside of the housing 86, see column 8, lines 43-58.).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to replace the touchpad cover taught by Ramey et al. with the touch pad covering device taught by Manser et al. in order to improve the

functionality of the touch pad such that it is operable in three modes: a relative mode, a first absolute mode and a second absolute mode.

Regarding claim 2, Ramey et al. and Manser et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. also disclose wherein the housing portion further includes an external surface (Figure 8, the surface 34 can be seen to be an external surface of the housing portion 32.).

Regarding claim 4, Ramey et al. and Manser et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. also disclose wherein the receiving portion has a concave portion (Figures 8 and 9 show that of the internal surface of housing 32, as explained in the rejection of claim 1, has the touch guard 60 as part of the housing's structure, meaning that that interior surface of the touch guard 60 is part of the internal surface of the housing. The interior surface of the guard member 60 is then part of the receiving portion since it contacts the touch pad 12 when closed, meaning that when the touch guard 60 is in the opened position that the internal surface of the housing when he touch guard 60 is received would be a concave portion of the receiving area.).

Regarding claim 7, Ramey et al. and Manser et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. and Manser et al. fail to teach of the notebook computer wherein the thickness of the receiving portion is about 0.5-0.8mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the thickness of the receiving portion between .5-.8 mm since a notebook computer is portable and it is important to have the overall size of the notebook computer be relatively small meaning that all the components located inside of the computer would also need to be small.

Regarding claim 8, Ramey et al. and Manser et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. and Manser et al. fail to teach of the notebook computer wherein the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing is about O.7-1.0 mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about 0.7-1.0 mm because it is important for the housing to keep a relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

Regarding claim 9, Ramey et al. and Manser et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. and Manser et al. fail to teach of the notebook computer wherein a ratio between the thickness of the receiving portion and the thickness a portion, adjacent to the receiving portion, of the housing is about 1/3-1/2.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the ratio between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about 1/3-1/2 mm because it is important for the housing to keep a relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ramey et al. (US 6,756,971) in view of Manser et al. (US 6,388,660) and further in view of Garner (US 6,501,462).

Regarding claim 3, Ramey et al. and Manser et al. disclose the notebook computer as claimed in claim 2.

Ramey et al. and Manser et al. fail to teach of a notebook computer wherein the housing further includes a flange on the external surface, and the flange surrounds the surface correspond to the receiving portion.

Garner discloses of a notebook computer wherein the housing further includes a flange on the external surface, and the flange surrounds the surface correspond to the receiving portion (Figure 1, item 39 and column 4, lines 5-12. The examiner interprets that item 39 is a flange which surround the touch pad portion item 35.).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the flange taught by Garner with the notebook computer taught by the combination of Ramey et al. and Manser et al. in order to provide tactile feedback such that the touchpad can be found without looking for it with the eye.

7. Claims 5-6 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramey et al. (US 6,756,971) in view of Manser et al. (US 6,388,660) and further in view of Keely, JR. et al. (US 2002/0063694).

Regarding claim 5, Ramey et al. and Manser et al. disclose the notebook computer as claimed in claim 1.

Ramey et al. and Manser et al. fail to teach of the notebook computer further comprising: an adhesive member adhering the touch pad to the receiving portion.

Keely, JR. et al. disclose of a notebook computer further comprising: an adhesive member adhering a touch pad to the outer surface opening (Paragraph [0041]).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to adhere the touch pad using adhesive as taught by

Keely, JR. et al. to the outer edges of the receiving portion of the notebook computer taught by the combination of Ramey et al. and Manser et al. in order to provide the desired stiffness, producing permanent alignment, shock control, the spread of impact forces along the edges, and liquid seal, with minimum cost, weight, and number of parts.

Regarding claim 6, Ramey et al. Manser et al. and Keely, JR. et al. disclose the notebook computer as claimed in claim 5.

Keely, JR. et al. also discloses wherein the touch pad is closely adjacent to the outer surface opening via the adhesive member, thereby eliminating any gap between the outer surface opening and the touch pad (Paragraph [0041]. The examiner interprets that when anything is sealed with an adhesive such that liquids are prevented from entering that the gap between the two items is eliminated.).

Regarding claim 10, this claim is rejected under the same rationale as claims 1 and 5.

Regarding claim 11, this claim is rejected under the same rationale as claims 5 and 6.

Regarding claim 12, this claim is rejected under the same rationale as claim 7.

Regarding claim 13, this claim is rejected under the same rationale as claim 8.

Regarding claim 14, this claim is rejected under the same rationale as claim 9.

Regarding claim 15, Ramey et al., Manser et al. and Keely, JR. et al. disclose the method as claimed in claim 10.

Ramey et al., Manser et al. and Keely, JR. et al. fail to teach of the method wherein the housing is formed by injection molding.

However, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to form the housing using injection molding since it is well known that the injection molding process has high production rates, allows design flexibility, has relatively low labor, and has minimum scrap losses.

Regarding claim 16, this claim is rejected under the same rationale as claim 4.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Singleton, JR. et al. (US 2004/0019724) disclose a computing system in which a PDA device can be inserted into a portable computer and used as the touchpad.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen G. Sherman whose telephone number is (571) 272-2941. The examiner can normally be reached on M-F, 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

AMR A. AWAD
SUPERVISORY PATENT EXAMINER

26 September 2006